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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/760,615 | 01/20/2004 | Charles B. Perkins | 05017-UPA | 9960 |
| 56758 | 7590 | 01/04/2007 | EXAMINER | |
| KNOX PATENTS P.O. BOX 30034 KNOXVILLE, TN 37930-0034 | | | LEE, JINHEE J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2174 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 01/04/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|-----------------|----------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/760,615 | PERKINS ET AL. | |
| | Examiner | Art Unit | |
| | Jinhee J. Lee | 2174 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 October 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
 - 4a) Of the above claim(s) 2,3,7,8,12 and 13 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,4-6,9-11 and 14 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. This application contains claims 2,3,7,8, 12 and 13 drawn to an invention nonelected with traverse in Paper dated 5/24/06. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Specification

2. The disclosure is objected to because of the following informalities:

At page 7 line 29 according to the numbering on the left, "face plate 704" is confusing. Change to "face plate 702" to conform with rest of the application.

Appropriate correction is required as stated before.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 6, 9, 10, 11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hall et al. (5608196).

Re claim 6, Hall et al. discloses a controller for a residential low voltage control system, said controller adapted to be received by an electrical box, said controller comprising: a face plate (8 for example) having a front side and a back side, said face plate adapted to secure said face plate to the electrical box (via apertures unnumbered

Art Unit: 2174

on 8 and 12 for example), said face plate adapted to secure a cover plate (via unnumbered apertures on 8 and/or 72 for example) to said face plate; a module (24 with 22 for example) for controlling a driven device, said module secured to said back side of said face plate, said module having power connections (via 16 for example); and a terminal block (28 for example) accessible from a front side of said face plate for making a plurality of low voltage terminations, said terminal block electrically connected to said module for communicating at least one low voltage control signal (see column 5 lines 5-8 for example), said terminal block adapted to route a plurality of low voltage conductors from said terminal block out of the electrical box while maintaining separation from said power connections inside said electrical box (see figures 1 and 2). Note, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Re claim 9, Hall et al. discloses a controller wherein said face plate has a substantially flat surface, said low voltage terminal block received in an aperture in said substantially flat surface (see figure 2 for example).

Re claim 10, Hall et al. discloses a controller wherein said face plate has a substantially flat surface, said low voltage terminal block received in an aperture in said substantially flat surface, said low voltage terminal block having a low profile (see figures 1 and 2).

Re claim 11, Hall et al. discloses a controller for a residential low voltage control system, said controller adapted to be received by an electrical box, said controller

comprising: a means for securing a low voltage controller in an electrical box (see figure 1 for example); a means for terminating (with 28 for example) a plurality of low voltage conductors to said controller (see figure 2 for example); and a means for isolating said plurality of low voltage conductors from a plurality of power conductors in said electrical box (see figure 2 for example). Note, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Re claim 14, Hall et al. discloses a controller wherein said means for isolating includes a controller having a face plate (8 for example) that is substantially flat, said means for terminating (with 28 for example) protruding from an opening in said face plate (see figures 1 and 2).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allread (2096503) in view of Hall et al.

Re claim 1, Allread substantially discloses an apparatus for a residential low voltage control system operated by a door, said apparatus comprising: a controlled device (lighting for example, see page 1 left column lines 12-14 according to the numbering on the left); a switch (5 for example) actuated by the door (7 for example), said switch having a ball actuator (see figure 1 for example). Allread does not explicitly disclose an electrical box containing a plurality of power conductors, at least one of said plurality of power conductors connected to said controlled device; and a controller having a face plate and a low voltage terminal block, said controller mounted in said electrical box with said face plate located adjacent to and parallel to a major opening of said electrical box, said face plate adapted to secure a cover plate to said face plate, said controller connected to a circuit including said plurality of power conductors whereby said controller controls the operation of said controlled device, said controller outputting a low voltage signal to said switch through said low voltage terminal block, said low voltage terminal block having a plurality of terminals accessible from a front side of said face plate, said low voltage terminal block adapted to route a plurality of low voltage conductors from said plurality of terminals out of said electrical box while maintaining separation from said plurality of power conductors inside said electrical box.

However, Hall et al. teaches of an electrical box (12 for example) containing a plurality of power conductors (16 for example), at least one of said plurality of power conductors connected to said controlled device (see column 4 line 60 according to the numbering in the middle); and a controller having a face plate (8 for example) and a low voltage terminal block (28 for example), said controller mounted in said electrical box with said face plate located adjacent to and parallel to a major opening (unnumbered on 12 for example) of said electrical box, said face plate adapted to secure a cover plate to said face plate, said controller connected to a circuit including said plurality of power conductors whereby said controller controls the operation of said controlled device, said controller outputting a low voltage signal to said switch through said low voltage terminal block, said low voltage terminal block having a plurality of terminals accessible from a front side of said face plate, said low voltage terminal block adapted to route a plurality of low voltage conductors from said plurality of terminals (14 for example) out of said electrical box while maintaining separation from said plurality of power conductors inside said electrical box (see figures 1 and 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an electrical box containing a plurality of power conductors, at least one of said plurality of power conductors connected to said controlled device; and a controller having a face plate and a low voltage terminal block, said controller mounted in said electrical box with said face plate located adjacent to and parallel to a major opening of said electrical box, said face plate adapted to secure a cover plate to said face plate, said controller connected to a circuit including said plurality of power conductors whereby said controller controls the

operation of said controlled device, said controller outputting a low voltage signal to said switch through said low voltage terminal block, said low voltage terminal block having a plurality of terminals accessible from a front side of said face plate, said low voltage terminal block adapted to route a plurality of low voltage conductors from said plurality of terminals out of said electrical box while maintaining separation from said plurality of power conductors inside said electrical box of Hall et al. with the device of Allread in order to provide controlling system for the lighting. Note, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Also note, it has been held that the functional "whereby" statement does not define any structure and accordingly cannot serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

Re claim 4, note that Hall et al. teaches of an apparatus wherein said face plate has a substantially flat surface, said low voltage terminal block received in an aperture (unnumbered on 8 for example) in said substantially flat surface (see figure 2).

Re claim 5, note that Allread discloses an apparatus wherein said switch is mounted in a upper horizontal frame member of the door (see figures 1 and page 1 left column line 8 for example) whereby a top surface of said door actuates said ball actuator when the door is in a closed position. Note, it has been held that the functional "whereby" statement does not define any structure and accordingly cannot serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

Response to Arguments

8. Applicant's arguments filed 10/11/06 have been fully considered but they are not persuasive.

In response to applicant's arguments that the prior art teaches of dip switch, not a terminal block, examiner disagrees. The dip switch, item 28, provides multiple termination points, as is the function of a terminal block.

In response to applicant's arguments regarding claim 11, the means for function is pointed out in the rejection above.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both prior arts are switches.

Note, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., two different levels of voltage are present, a high voltage for the power conductors

to the controlled device and a low voltage for the connection to the switch) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinhee J. Lee whose telephone number is 571-272-1977. The examiner can normally be reached on M-F at 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on 571-272-2100 ext. 74. The fax phone

Art Unit: 2174

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jinhee J Lee
Primary Examiner
Art Unit 2174

jjl

